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UNITED STATES PATENT AND TRADEMARK OFFICE
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HENRY T. BRENDZEL
P.O. BOX 574
SPRINGFIELD, NJ 07081

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JUL 25 2005

In re Application of :
Calderbank et al. :
Application No. 09/300,494 :
Filed: April 28, 1999 : **OFFICE OF PETITIONS**
Attorney Docket Number: :
CALDERBANK-1 :

ON PETITION

This is in response to the Request for Reconsideration and Petition Under Rule 37 C.F.R. 1.183 or, in the Alternative, Petition Under 37 CFR Rule 137(4)(b), filed April 28, 2004. The petitions are treated as a request for reconsideration under 37 CFR 1.181, a petition under 37 CFR 1.183 and 37 CFR 1.137(b).

The petitions are **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly respond to the final Office action, mailed April 23, 2003. The Office action set a three (3) month period for reply.

Applicant filed an Amendment on via facsimile on July 31, 2003, along with a one (1) month extension of time request; however, the Amendment was apparently not received in the Technology Center at that time.

A Notice of Abandonment was mailed December 12, 2003.

Applicant filed a Petition to Withdraw the Holding of Abandonment on based upon Applicant's timely filed Amendment on

December 22, 2003, and provided a copy of the timely filed Amendment. A review of the Amendment revealed that the Amendment was Non-compliant, and failed to place the application in condition for allowance. In a Decision mailed April 8, 2004, the petition was dismissed, and Applicant was notified in a Notice of Non-compliant Amendment that the Amendment failed to place the application in condition for allowance.

Having failed to timely and properly reply to the final Office action, the application became abandoned July 24, 2003.

The instant petition

Applicant files the instant Request for Reconsideration and provides that the set of claims filed in the July 31, 2003 Amendment was "the same set of claims that was presented to the Examiner in a previous Office Action response, and the Examiner did not point out the problem at that time." Petition at p.2. Furthermore, Applicant asserts, "the mistaken listing did not miss any claims. It merely failed to identify the status of the claims that are already NOT in the case." Id. Applicant asserts that "[s]ubstantively, the last amendment placed that case in condition for allowance." Id. Accordingly, Applicant requests withdrawal of the holding of abandonment. Applicant avers that "[b]ut for the failures of the PTO... the case surely would have been issued." Id. Applicant asserts that this is an extraordinary situation and, "in the interest of justice, the Rule or Rules that pertain to this matter be suspended for this time."

A further review of the Amendment filed with the petition to withdraw abandonment on December 22, 2003

A further review of the Amendment filed with the petition to withdraw abandonment on December 22, 2003 reveals that the Amendment raises new issues and will not be entered by the Examiner. A copy of the Advisory Action follows under separate cover.

Request for Reconsideration under 37 CFR 1.181

Applicable Law/Rules/MPEP and Analysis

Regarding Applicant's assertion that "[s]ubstantively, the last amendment placed that case in condition for allowance," the

Office finds this assertion is without merit. Accord the Advisory Action which follows under separate cover.

Regarding Applicant's argument that "[b]ut for the failures of the PTO... the case surely would have been issued."

The Manual for Patent Examining Procedure ("MPEP"), section 711.02, provides:

37 CFR 1.135(a) specifies that an application becomes abandoned if applicant 'fails to reply' to an office action within the fixed statutory period. This failure may result either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e. failure to file a 'complete and proper reply, as the condition of the case may require' within the statutory period (37 CFR 1.135(b)).

This section clearly explains that abandonment occurs when Applicant fails to timely and properly reply to the outstanding Office action.

Further to this, Applicant is directed to 37 CFR 1.135(b), Abandonment For Failure to Reply Within Time Period, which reads:

Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

This section is further clarified in the MPEP, which provides

[f]or example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not 'unavoidable' when the applicant simply permits the maximum extendable statutory period

for reply to a final Office action to expire while awaiting a notice of allowance or other action.

This section explains that a delay is not unavoidable when the applicant-petitioner is awaiting an action from the examiner. In other words, when Petitioner filed the response to the final Office action, it was Petitioner's responsibility to file a complete and proper reply as the application required. The Notice of Non-compliant Amendment (as well as the Advisory Action accompanying this Decision) was (are) a courtesy mailed to Applicant which attempted to notify Applicant that the filed response failed to comply with what was required. The time to file a complete and proper reply continued to run from the mailing of the Office action on April 23, 2003.

Applicant is further advised that a proper response to a final rejection must be in the form of an appeal; a request for continued examination or a continuation application. The filing of an amendment placing the application in condition for allowance is permitted under these rules, but entry of such amendment is not a matter of right. While the Office attempts to promptly respond to an amendment after final, there are those instances, as here, where delays do occur. However, it is clear from 37 CFR 1.116 that abandonment of the application is risked when an amendment after final Office action is filed.

Accordingly, the Request for Reconsideration of Petition Under 37 CFR 1.181 is dismissed

After a decision on a petition for reconsideration under 37 CFR 1.181, no further reconsideration or review of the matter will be undertaken by the Commissioner under 37 CFR 1.181.

Therefore, it is extremely important that petitioner supply any and all relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence.

Petition under 37 CFR 1.183

It is well settled that a party's inadvertent failure to comply with the requirements of the rules or procedures before the USPTO is not deemed to be an extraordinary situation that would warrant waiver of the rules or procedures Under 37 CFR 1.183.

See Honigsbaum v. Lehman, 903 F.Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where application was actually deposited with USPS as "Express Mail") aff'd without opinion, 95 F.3d 1166 (Fed. Cir.1996); Nitto Chemical Industry Co., Ltd. V. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care and diligence, and thus is not an extraordinary situation under 37 CFR 1.183); Gustafson v. Strange, 227 USPQ 174 (Comm'r Pats. 1985) (Counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule). Rather, as Applicant failed to comply with the provisions of 37 CFR 1.135, this is not an "extraordinary situation" where "justice requires" an extraordinary remedy.

Accordingly, the petition under 37 CFR 1.183 is dismissed.

The petition under 37 CFR 1.137(b)

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a notice of appeal and the requisite fee; a request for continued examination; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c);; (2) the petition fee required by 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) if required, a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)).

This petition lacks items (1) and (3) above. As to item (1), Applicant has failed to provide the required reply. As previously noted, the reply filed with the petition

on December 22, 2003 (Certificate of mailing dated July 31, 2003), fails to place the application in condition for allowance. The required reply must be filed.

As to item (3), Applicant has failed to provide a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

Accordingly, the petition under 37 CFR 1.137(b) is dismissed.

Applicant's deposit account has been charged the fee for filing a petition under 37 CFR 1.137(b) in effect at the filing of the petition, \$1330.00 as authorized in the petition.

The application file is being forwarded to Technology Center Art Unit 2634 for mailing of the Advisory Action.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


Derek L. Woods
Petitions Attorney
Office of Petitions